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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/776,673

02/10/2004

Katherine Musil

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02/10/2006

NATIONAL IP RIGHTS CENTER, LLC

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EXAMINER

POPE, DARYL C

ART UNIT

PAPER NUMBER

2632

DATE MAILED: 02/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,673

Applicant(s)

MUSIL, KATHERINE

Examiner

DARYL C. POPE

Art Unit

2632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

ART REJECTION:

Claim Rejections - 35 USC § 103

2. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingargiola et al(Ingargiola).

-- Claims 1-2 recite subject matter that is met by Ingargiola for the reasons of record as discussed in previous office action.

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ingargiola et al(Ingargiola) in view of Gaudet et al(6,052,654).

-- With regards to claim 3, the claimed subject matter that is met by Ingargiola includes:

- 1) the electronically activated controller is met by the circuit board(40);
- 2) the activation means and the activation means is met by the switch(54A);
- 3) the alarm means is met by the visual alarm(46).

- Ingargiola does not show:

- 1) the activation means being an accelerometer-based activation means.

As discussed in the previous office action, use of accelerometer-based activation means for activating a shoe alarm is well known in the art. In related art, Gaudet et al(Gaudet) discloses a foot contact measuring apparatus wherein signals from an accelerometer(34) contained in a shoe are analyzed so as to monitor user specific data

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with regards to impact threshold values for the shoe(see: column 16, lines 45 et seq).

These values are input to network processing circuitry, which allows a user to select parameters to be output for display and/or audio or vibrational indication(see: column 4, lines 27-54) which are then utilized for determining user activity in and alerting a user of health issues.

Since use of accelerometer-based activation in a shoe is well known as seen by Gaudet, it would have been obvious to one ordinary skill in the art at the time the invention was made to incorporate the accelerometer(34) of Gaudet into the switch(54A) of Ingargiola, since the accelerometer(34) of Gaudet would have provided an more accurate measurement of threshold impact than a mere pressure switch for determining an alarm activation for the switch(54A) of Ingargiola.

REMARKS:

Response to Arguments

4. Applicant's arguments filed 12/23/2005 have been fully considered but they are not persuasive.

5. **APPLICANT'S ARGUMENTS:**

1) *"Although some similarities exist between the present invention and the invention described in the Ingargiola et al patent.....However, the fact that the panic button function is only sparingly mentioned in the Ingargiola reference compared to its voluminous description of the tracking feature is strong evidence that the Ingargiola device is primarily a tracking device."*

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2) *"Furthermore, the panic button feature of the Ingargiola device only notifies the parent that the child is lost or in danger.....Ingargiola's alarm would only notify the parent or others near the handheld unit, who could hear the higher frequency alarm emitted by the handheld unit.";*

3) *"Applicant's invention can also be described as a monitoring device.....Therefore the monitoring capabilities of the present invention are greatly limited compared to the monitoring capacity of the Ingargiola invention which allows the parent/guardian to the shoe's wearer using the handheld transceiver."*

4) *"A key distinguishing feature between the Ingargiola device and the present invention is that the present invention is a separate device apart from the shoe itself.....The present invention is only affixed to the shoe so it could be lost more easily, depending on how it was affixed."*

5) *"The obvious disadvantage of having the shoe alarm integrated into the shoe is that it can only be used with one pair of shoes.....It would also make it less likely that the attacker would know of the tracking device's existence making it less likely that he or she would remove the shoes to avoid being tracked.";*

6) *"Section 2144.03(A) of the MPEP states that.....As the accelerometer is an important part of the present invention, the Applicant traverses the Examiner's claim that such knowledge is common in the field of shoe alarms and respectfully requests that the Examiner include specific evidence that the combination of accelerometers and shoe alarms is commonly known in the art.";*

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7) *"In conclusion, the Ingargiola device is primarily a monitoring device with a panic button being an incidental part of the invention.....Furthermore, as the two inventions do not have the same primary purpose it cannot have obvious to create one invention in view of the other."*

6. EXAMINER'S RESPONSE:

1) Applicant is arguing that the intended use of Ingargiola prevents the reference from meeting the limitation of the claimed subject matter. But the mere fact that Ingargiola is based on tracking an individual's footwear does not obviate the fact that Ingargiola also includes a pushbutton switch which, when pushed, activates an alarm in the same manner as that claimed in the present invention. Just because Ingargiola is directed to a certain use does not preclude it from meeting the limitations of other uses as well.

2) Applicant's argument is moot since the subject matter argued here has not been claimed.

3) See response 1 above.

4) It appears as though applicant is pointing out the advantages that the reference to Ingargiola has over the present invention. The basis for determining patentable subject matter is proving that that present invention has an advantage over the prior art, not the other way around. In view of this, applicant argument with regards to the disadvantages of the present invention is not deemed persuasive.

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5) Applicant is arguing that the device of the present invention is removably affixed to a shoe as opposed to being integrated into the shoe. Applicant is arguing subject matter that has not been claimed and therefore is moot.

6) Applicant's objection to examiner's use of Official Notice has been addressed in the art rejection above.

7) Applicant is arguing subject matter that has not been claimed and is therefore deemed moot.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DARYL C. POPE whose telephone number is 571-272-2959. The examiner can normally be reached on M-TH 9:00-7:30.

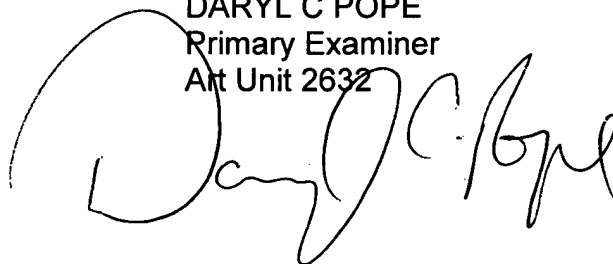
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, DANIEL J. WU can be reached on 571-272-2964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daryl C. Pope

Feb. 3, 2006

DARYL C POPE
Primary Examiner
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A handwritten signature in black ink, appearing to read 'Daryl C. Pope', is written over the printed name and title of the examiner.